



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,824	06/05/2000	David Godfrey Williams	17564-136	8718

30623 7590 02/10/2004

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

YAN, REN LUO

ART UNIT PAPER NUMBER

2854

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,824

Applicant(s)

WILLIAMS, DAVID GODFREY

Examiner

Ren L Yan

Art Unit

2854

AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2854

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-27 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,264,460 in view of Rasmussen(2,073,379). GB 2,264,460 teaches a metallic stencil sheet 3 of rectangular shape for printing solder on a circuit board including a metallic central body having one or more apertures formed through the stencil thickness to define pattern to be printed, and a plurality of elongated receiving apertures 6 and 7 which define a plurality of elongated slots separated by a plurality of elongated strips on two side edges of the stencil 3. See Figs. 1 and 3 in GB 2,264,460 for details. However, GB 2,264,460 lacks the receiving apertures on the other two side edges. The patent to Rasmussen teaches a stencil sheet 12 having receiving apertures 13 on all four side edges of the stencil sheet such that when the stencil sheet is mounted onto a frame, the apertures are engaged with pins 16 and the stencil sheet will be stretched substantially equally in all directions. See Figs. 6 and 8, and column 1, line 42 through column 3, line 22 in Rasmussen for example. It would have been obvious to those having ordinary skill in the art to provide the metal stencil 3 in GB 2,264,460 with receiving apertures along all four side edges of the stencil as taught by Rasmussen in order to ensure uniform tensioning upon mounting the stencil onto a frame. With respect

Art Unit: 2854

to claim 31, Fig. 1 of GB 2,264,460 shows more than twenty receiving apertures along one side edge of the stencil as recited.

Applicant's arguments filed on 11-10-2003 have been fully considered but they are not persuasive.

In response to applicant's argument that neither Rasmussen nor GB 2,264,460 in any way suggest that the metals that form the stencils in GB 2,264,460 could be substituted for the rubber in Rasmussen's highly elastic stencil, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). GB 2,264,460 teaches the same type of metal stencil as used in the present invention and the Rasmussen patent is relied upon its teaching of applying tension to all 4 sides of the stencil so as to achieve equal tension on all sides of the stencil. As stated by the applicant that GB 2,264,460 desires that its stencil is tensioned without distortion. When uniform tension can not be achieved with tensioning apertures provided only on two sides of the stencil, one of ordinary skill in the art would look to the teaching of Rasmussen and be motivated to provide tensioning apertures on all 4 sides of the stencil in GB 2,246,460 in order to achieve equal or uniform tension on the stencil. Accordingly, the combined teachings of GB 2,246,460 and Rasmussen would have suggested to those of ordinary skill in the art to apply the teaching of Rasmussen to the stencil of GB 2,246,460 as suggested by the Examiner above.

Art Unit: 2854

Applicant also argued that GB 2,264,460 teaches against providing apertures along all four edges of the stencil because it claims that the provision of two flexible edges with closely spaced apertures make it possible to avoid the transmission of any tensioning distortion to the main body of the stencil. This argument is not agreed to by the Examiner. GB 2,264,460 does not teach against providing apertures along all four edges of the stencil. Rather, GB 2,246,460 teaches providing apertures along two edges of the stencil to avoid the transmission of any tensioning distortion to the main body of the stencil. One of ordinary skill in the art, during the actual practice of using the GB 2,246,460 stencil and realizing that the tension on the stencil is not at its desired level, would look to the teaching of Rasmussen and provide tensioning apertures along all four edges of the stencil in order to improve the performance of the stencil.

Applicant's attorney's statement that the stencil of the present invention offered evidence of a long-felt need in the PCB fabrication industry is not supported by any appropriate affidavit or declaration and is not evidence itself. Therefore, this statement is not given any weight. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) See MPEP 716.01(c).

The declaration under 37 CFR 1.132 filed on 11-10-2003 is insufficient to overcome the rejection of claims 24-27 and 29-33 based upon GB 2,246,460 in view of Rasmussen as set forth in the above Office action because: it includes gross sales figures of all metallic stencils with apertures for engagement along four edges made by the inventor of the present application and competitors. Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric products, Inc. v.*

Art Unit: 2854

Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d, 1454 (Bd. Pat. App. & Inter. 1988)

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

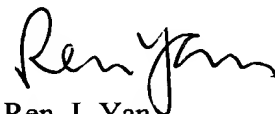
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 703-308-0978.

The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
Feb. 6, 2004